

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 1-64 and 66-77 are pending. Claims 1-64 and 66-77 stand rejected.

Claims 1, 33, 34, 61-62 have been amended. No claims have been canceled. No claims have been added. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. Applicant submits that the amendments do not add new matter.

Applicant reserves all rights with respect to the applicability of the Doctrine of Equivalents.

The Examiner stated that “the specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.” (Office Action, 4/24/08, p. 3).

Without agreeing with the Examiner’s objections, applicant has removed “third” and “fourth” wording from the claims 1-64, and 66-77.

Therefore, applicant respectfully submits that the Examiner’s specification objection with respect to wording “third” and “fourth” has been overcome.

With respect to claim 61, the Examiner stated that “there is no any support for ‘a document index input device’ in the...original disclosure.” (Office Action, 4/24/08, p. 3).

Applicant respectfully submits that “a document index input device” is supported by original claim 61.

Applicant has amended the specification to include the limitations of original claim 61 into the specification.

Therefore, applicant respectfully submits that the Examiner’s specification objection with respect to “a document index input device” has been overcome.

The Examiner has objected to the drawings.

Without agreeing with the Examiner's objections, applicant has removed "third" and "fourth" wording from the claims 1-64, and 66-77.

Therefore, applicant respectfully submits that the Examiner's drawings objection with respect to wording "third" and "fourth" has been overcome.

Applicant has amended the identifier of claim 3 to read "Previously Presented" to overcome the Examiner's objection with respect to claim 3.

Applicant has amended claims 62-64 to replace "apparatus defined in" with "system of".

Therefore, applicant respectfully submits that the Examiner's objections of claims 62-64 have been overcome.

Claims 1-64 and 66-77 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,682,540 of Klotz, Jr., et al. ("Klotz") in view of U.S. PA Publication No. 2002/0080387 A1 of Grasso, et al. ("Grasso").

Amended claim 1 includes identifying at least one action from the plurality of actions set forth in the image; and identifying at least one document from the plurality of documents for the at least one action identified from the plurality of actions, wherein the identifying the at least one action from the plurality of actions set forth in the image is performed based on the second plurality of the indication areas in the image, the identifying the at least one document from the plurality of documents is performed based on the first plurality of the indication areas in the image.

The Examiner acknowledged that Klotz "does not...teach 'a second plurality of indication areas associated with a plurality of actions; and identifying at least one action from the plurality of actions set forth in the image, wherein the identifying the at least one action from the plurality of actions set forth in the image is performed based on the second plurality of the indication areas in the image'." (Office Action, 4/24/08, p. 7).

Klotz discloses a system for representing electronic files using a paper based medium.

More specifically, Klotz discloses the following:

Having discussed implementation details, additional advantages and features of document surrogates will now be discussed. For example, FIG. 4 shows a document surrogate that acts as a "document catalog". A document catalog is a document surrogate that contains summaries of more than one document. Document surrogate 80, as depicted, contains summaries of four different documents. Each document summary contains document selection box 82, first window 84, and second window 86. First window 84 may contain a summary of the document that is of primary importance or other information concerning the document. Second window 86 is depicted as a nine window summary of the document and may contain reduced images.

Selection box 82 is a way for a user to select a subset of documents that are summarized on the surrogate. The user need only place a check mark in each selection box 82 to make an appropriate selection. The document processing system will parse the machine readable code 32 for the existence of selection boxes affixed on the surrogate. The document processing system will then know to scan the image where selection boxes 82 are located and detect the presence or absence of user supplied selections. If the document processing system detects the presence of such a mark, the system knows to append the selected document to the new document the system is creating.

(Klotz, col. 13, line 50-col. 14, line 37)(emphasis added)

Thus, Klotz merely discloses selecting a document from the plurality of documents on the surrogate.

Accordingly, Klotz fails to disclose identifying at least one action from the plurality of actions set forth in the image; and identifying at least one document from the plurality of documents for the at least one action identified from the plurality of actions set forth in the image, as recited in amended claim 1.

Grass, in contrast, teaches the following:

The output cover sheet usually has a lot of free space which can be used as an input field for requesting services from the knowledge management service, for providing user comments or explicit ratings or as a convenient output space for printing other information, for example about the document or the work group. The additional space on the cover sheet enables the cover sheet to be used an input mechanism to other Paper UI systems or to the knowledge management system. The cover sheet may include, for example, checkboxes for selecting predefined services from the knowledge management service, such as storing a copy of the printed document in memory, archiving the document permanently, making the document public, erasing the document from

memory, classifying the document, providing comments or ratings to a recommender service.

(Grasso, paragraph [0019])(emphasis added)

Thus, Grasso merely discloses selecting a service from the predefined services on the cover sheet. In contrast, amended claim 1 refers to identifying at least one action from the plurality of actions set forth in the image; and identifying at least one document from the plurality of documents for the at least one action identified from the plurality of actions set forth in the image, as recited in amended claim 1.

Thus, neither Klotz, nor Grasso discloses, teaches, or suggests such limitations of amended claim 1.

It is respectfully submitted that Klotz does not teach or suggest a combination with Grasso, and Grasso does not teach or suggest a combination with Klotz. It would be impermissible hindsight, based on applicant's own disclosure, to combine Klotz and Grasso.

Furthermore, even if the knowledge management system of Grasso were incorporated into the system for representing electronic files of Klotz, such a combination would still lack identifying at least one action from the plurality of actions set forth in the image; and identifying at least one document from the plurality of documents for the at least one action identified from the plurality of actions set forth in the image, as recited in amended claim 1.

Therefore, applicant respectfully submits that amended claim 1 is not obvious under 35 U.S.C. § 103(a) over Klotz in view of Grasso.

For at least the same reasons as discussed above, it is respectfully submitted that claims 2-64, and 66-77 are not obvious under 35 U.S.C. § 103(a) over Klotz in view of Grasso.

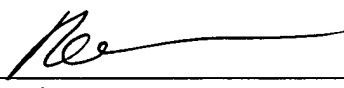
It is respectfully submitted that in view of the amendments and arguments set forth herein, the applicable rejections and objections have been overcome. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

If there are any additional charges, please charge Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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By:   
Tatiana Rossin  
Reg. No. 56,833

1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040  
(408) 720-8300

Customer No. 008791